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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,428	10/28/2003	Guenter Schmidt	34874-360/2003P00634US	4467

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EXAMINER

ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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10/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,428	SCHMIDT ET AL.	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/04, 2/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. **Claims 10 and 25** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The Examiner asserts that the summary of terms is essentially the contract that was already generated in claim 14 since a contract contains the terms of agreement, which are based on the responsive bids, as well as any agreements that may have been made during negotiations.

3. **Claims 12 and 27** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The Examiner asserts that by incorporating information from a prior contract into the new contract the terms from the prior contract have already been extracted.

4. **Claim 28** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As best understood a term sheet is a summary sheet detailing terms and conditions of an investment opportunity (see http://www.altassets.net/hm_glossary.php#term_sheet). The Examiner asserts that the bid invitation is already a term sheet since claim 14 has already stated that the bid invitation includes offered terms and requested terms.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 4, 14 – 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claim 4** recites the limitation "**the highest scoring bidder**" in **line 1 of claim 4**.

There is insufficient antecedent basis for this limitation in the claim.

8. **Claim 14** recites the limitation "**the renewal indication**" in **line 3 of claim 14**.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1 – 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Davis et al. (US PGPub 2006/0149653 A1)** in view of **Dan et al. (US PG Pub 2002/0178103 A1)**.

11. In regards to **claims 1, 12, 14 and 27**, **Davis** discloses a computer-implemented method of generating contracting documents, comprising:

receiving a contract renewal indication (**Page 1 ¶ 13 – 14**);

generating a bid invitation in response to the renewal indication, the bid invitation including a plurality of offered terms and a plurality of requested terms (**Page 2 ¶ 23; Page 3 ¶ 34**);

receiving one or more bid responses (**Page 3 – 4 ¶ 35**).

Davis discloses that contract terms and conditions are posted in order to allow negotiations to take place between a buyer and a seller. Moreover, the initiating user allows the responding user to open its proposal for changes, and a contract may then be awarded. Further still, **Davis** discloses that purchasing events may be replenishment events. Replenishment events are regularly scheduled events at which previously approved sellers quote on items designated by the purchaser from a list of regularly purchased items (**see Page 1 ¶ 7, 10; Page 4 ¶ 35**). However, **Davis** fails to explicitly state:

generating a contract by incorporating information from a previous contract and one of the responsive bids.

Dan, however, discloses that it is old and well known for contracts to be formed from information provided by one or more parties in one or more electronic documents

prior to the negotiation. Specifically, **Dan** teaches that a starting state of a contract can be formed from a previous contract (see Page 1 ¶ 8; Page 2 ¶ 10; Claim 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view **Davis**, which teaches the concept of replenishment purchasing events that already contain previously approved seller quotes, in view of **Dan**, which teaches that new contract can be formed based on prior contracts, since both teach the concept of using previously used information (seller information and contract information) to create a new agreement.

Regarding the system components to carry out the method steps, **Davis** discloses a method of computer assisted procurement of products to be purchased over an Internet website (see claim 31, for example). Although, **Davis** fails to explicitly disclose a storage device, an interface, invitation generator, and contract generator the Examiner asserts that all the components are obviously included. As discussed above, the combination of **Davis and Dan** discloses using previously used information to create a new agreement wherein it would have been obvious to one of ordinary skill in the art that the previously used information must be stored on the computer system, such as in the form of cookies. Further still, **Davis** e-mailing buyer invitations to sellers identified by the buyers, wherein it would have been obvious to one of ordinary skill in the art that the invitations are in electronic form and, thus, would have to have been generated electronically, which also holds true for the contract generator as well. Lastly, all of the above-mentioned steps can only have been accomplished because an

interface had to obviously been included, such as an input device like a mouse and keyboard and a monitor so that the website, bids, and other information can be viewed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention that **the combination of Davis and Dan** obviously included a storage device, interface, and bid invitation and contract generator in order to properly carry out the above-mentioned steps.

12. In regards to **claim 15**, **Davis** discloses wherein the contract renewal indication is associated with the expiration of a prior contract (**Page 2 ¶ 15; Page 12 ¶ 205**).

13. In regards to **claim 16**, **Davis** discloses wherein the contract renewal indication comprises instructions from a user to initiate a new contract (**Page 3 ¶ 33; Page 3 – 4 ¶ 35; Page 10 ¶ 147**).

14. In regards to **claims 2 and 17**, **Davis** discloses further comprising scoring the bids according to a predetermined scoring standard (**Page 2 ¶ 17; Page 10 ¶ 148**).

15. In regards to **claims 3 and 18**, **Davis** discloses further comprising selecting the one of the responsive bids from which the new contract is formed (**obviously included; see also Page 1 ¶ 7, 10; Page 4 ¶ 35**).

16. In regards to **claims 4 and 19**, **Davis** discloses further comprising selecting the highest scoring bidder for the new contract (**Page 1 ¶ 14; Page 4 ¶ 35; Claim 7(ii)**).

17. In regards to **claims 5 and 20**, **Davis** discloses further comprising triggering the generation of a bid invitation upon the occurrence of the pending expiration of a prior contract (**Page 2 ¶ 15, 22**).

18. In regards to **claims 6 and 21**, **Davis** discloses further comprising triggering the generation of a bid invitation upon the meeting of a target quantity on a prior contract (**Page 1 ¶ 13, 14**).

19. In regards to **claims 7 and 22**, **Davis** discloses wherein a portion of the new contract is formed based on previously agreed upon terms between the buyer and a selected bidder (**Page 1 ¶ 7, 13, 14; Page 5 ¶ 96; Page 3 – 4 ¶ 33 – 35; wherein in a replenishment purchasing event sellers have already been pre-approved**).

20. In regards to **claims 8 and 23**, **Davis** discloses wherein a portion of the new contract is formed based on provisions selected by the buyer during performance of a prior contract (**Page 1 ¶ 7, 13, 14; Page 5 ¶ 96; Page 3 – 4 ¶ 33 – 35; wherein in a replenishment purchasing event sellers have already been pre-approved**).

21. In regards to **claims 9 and 24**, **Davis** discloses wherein the bid invitation offers a plurality of selectable provisions associated with a contract clause (**Page 2 ¶ 23; Page 3 ¶ 34; Page 1 ¶ 7, 10; Page 4 ¶ 35**).

22. In regards to **claims 10 and 25**, **Davis** discloses further comprising generating a summary of terms from the responsive bids (**Page 2 ¶ 17; 4 – 5 ¶ 35**).

23. In regards to **claims 11 and 26**, **Davis** discloses further comprising supervising contracting workflow to allow for approval of the new contract (**Page 10 ¶ 146; Page 14 ¶ 254**).

24. In regards to **claim and 28**, **Davis** discloses wherein the bid invitation is provided in the form of a term sheet (**Page 2 ¶ 23; Page 3 ¶ 34**).

Conclusion

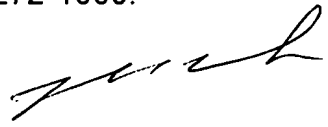
25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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10/5/07


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